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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,649	04/09/2001	Wolfgang Neifer	7904.0029	7819

22852 7590 10/17/2003

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EXAMINER

ST CYR, DANIEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/762,649	Applicant(s) NEIFER, WOLFGANG	
	Examiner Daniel St.Cyr	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Acknowledgment is made of applicant's response filed 7/14/03.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathurin, Jr., US Patent No. 5,473,144 in view of Ishii, US patent No. 5,768,389.

Mathurin, Jr. discloses a credit card with digitized fingerprint and reading apparatus comprising: a credit card finger print reading apparatus 10 on top of a table 28 exhibiting a credit card 12 containing therein an actual and/or digitized finger print of an authorized credit card holder being scanned by the apparatus 10 whereas the credit card is inserted in the credit card insertion slot 18. The apparatus 10 further exhibiting an access door 14 housing auxiliary power means 32 and a power on/off switch 16. The cardholder places his/her finger on the fingerprint-scanning screen 20 located on the angled front face 30 and the fingerprint is scanned by the finger print scanner 22. If the finger print scanned by the finger print scanner 22 and the finger print scanned on the credit card do not match then the red indicator light 24 illuminates alerting the user that a fraudulent transaction is about to take place. If the green indicating light 26 illuminates, then the user is alerted that the card and card holder are valid (see figures 1-4; col. 14, line 43+).

Mathurin, Jr. fails to disclose or fairly suggests that a "chip card" formatted into a pc card and that the fingerprint sensor comprises an interface coupled with the chip card reader.

Ishii discloses a method and system for generation and management of secret key of public key cryptosystem comprising: a PC chip card 34/200 including personal ID 210 for uniquely identifying the user; a terminal 33; a network 32; and a server 31 (see figure 1, 13 and col. 11, line 20+).

In view of Ishii's teachings, it would have been obvious for an artisan at the time the invention was made to modify the system of Mathurin, Jr. by modifying the reader to read the well-known chip card, PC card and to provide network connection so that users could be verified by cross-referencing the acquired data from the user with the data stored in the card or having a remote database with the identification information therein to identify the users. Such modification would make the system more practical wherein users could be identified even if their card is damage or the information became unreadable from the card. Furthermore, such modification would allow the system to be configured in a way such that users could use their personal computer to verify and update information in the chip card, which would make the system more effective and more convenient for users to process and execute/balance their credit transactions. Therefore, it would have been an obvious extension as taught by Mathurin.

Re claim 10, the specific connection of the component parts falls within the engineering design choice for providing certain ergonomic design or for minimizing the size of the system, failing to provide any unexpected results. Therefore, it would have been obvious for an ordinary artisan to couple the component parts in such way to achieve any ergonomic design combination.

Response to Arguments

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4. Applicant's arguments filed 7/14/03 have been fully considered but they are not persuasive. (See examiner remarks).

REMARKS:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, chip cards in the form of PC card are well known in the art are notoriously old and well known in the art for storing personal and financial transactions and combining these teaching would make the card more practical and more convenience so the users could use their personal computer to manage the information in the card.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant's arguments are not persuasive. Refer to the rejection above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

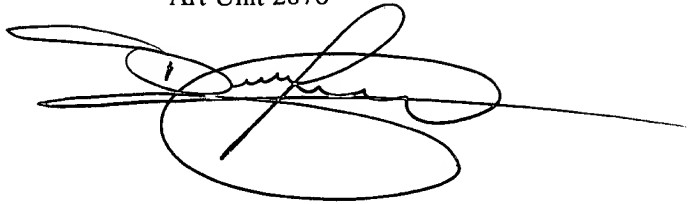
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Daniel St.Cyr
Primary Examiner
Art Unit 2876

DS
October 2, 2003

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over the printed name. The signature is stylized with a large loop and a horizontal line extending to the right.